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surface; and

a second panel including a second display, said second panel adapted to be opened and closed with respect to said first panel about an axis located at an edge of said first display.

REMARKS

Entry of this Amendment is proper under 35 CFR §1.116, since no new claims are added, no new issues are raised, and the response contained herein merely addresses the Examiner's response contained in the Office Action dated September 20, 2002, thereby clarifying the issues for imminent appeal. That is, the claim amendments contained herein merely correct grammar.

Attached hereto is a marked up version of the changes made in the specification and claims by the current Amendment. The attached page is captioned "Version with markings to show changes made."

Claims 1-30 are all of the claims pending in the present Application. Claims 1 and 23-25 stand rejected under 35 USC §103(a) as unpatentable over US Patent 6,072,476 to Harada et al. Claim 2 stands rejected under 35 USC §103(a) as unpatentable over Harada, further in view of US Patent 5,659,361 to Jin. Claims 3, 8, 11, and 26 stand rejected under 35 USC §103(a) as unpatentable over Harada, further in view of Jin, and further in view of US Patent 6,256,020 to Pabon et al. Claims 4, 5, 12-14, and 27 stand rejected under 35 USC §103(a) as unpatentable over Harada, further in view of Jin, further in view of Pabon, and further in view of US Patent 5,121,112 to Nakadozono. Claims 6, 9, 15-18, and 28-30 stand rejected under 35 USC §103(a) as unpatentable over Harada, further in view of Jin, further in

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view of Pabon, further in view of Nakadozono, and further in view of US Patent 5,710,600 to Ishii et al. Claims 7, 10, and 19-22 stand rejected under 35 USC §103(a) as unpatentable over Harada, further in view of Jin, and further in view of Pabon, and further in view of US Patent 5,982,429 to Kamamoto et al.

These rejections are respectfully traversed in view of the following discussion.

I. THE CLAIMED INVENTION

As disclosed and described by the claims, e.g., claim 1, the present invention is directed to a vehicle-mounted apparatus including a first panel having a first display. The first panel is adapted to be mounted onto a surface in a vehicle. The apparatus includes a second panel having a second display. The second panel is adapted to be opened and closed with respect to the first panel about a side thereof as an axis.

II. THE PRIOR ART REJECTIONS

Applicants again respectfully point out that the rejection of record fails to meet the burden of a *prima facie* rejection under 35 USC § 103(a) and again respectfully point out that the Examiner fails to follow the examining procedure set out in the MPEP by failing to heed that the primary reference explicitly teaches against the combination urged by the Examiner.

In addition to the shortcomings already identified in the previous Amendment filed September 3, 2002, and which will not be repeated herein, Applicants add the following points to address the Examiner's response in the Office Action dated September 20, 2002.

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In summary and as described in greater detail below, Applicants respectfully assert that the rejection on record fails to properly acknowledge that the primary reference, US Patent 6,072,476 to Harada et al., explicitly teaches against the combination urged by the Examiner, and that the rejection on record thereby fails to properly evaluate the claimed invention by failing to consider the invention "as a whole" (see final paragraph of MPEP §2141.03).

A. The Additional Citation to US Patent 6,067,078 to Hartman

The Examiner is understood as agreeing that Harada fails to teach or suggest the use of that apparatus in a vehicle. The Examiner is also understood as taking the position that, because it is well known, as demonstrated by US Patent 6,067,078 to Hartman, that LCD displays are used in vehicles, it would, therefore, be obvious to mount the Harada device in a vehicle.

The first basic flaw in the Examiner's position is that the Applicants are not pretending to claim the generic use of LCD displays in a vehicle. Rather, the claimed invention addresses a very specific configuration comprising two display panels for a vehicle-mounted apparatus.

Second, although an LCD could be used as one or both display panels in the present invention, it is noted that the present invention is not intended to be limited to LCD display technology, since a display for a television or a navigation system could certainly comprise configurations other than LCD technology.

Third, as previously pointed out in the previous Amendment and as the Examiner is understood to agree, the Harada reference clearly is not intended to be mounted to a surface in a vehicle, since reading a portable electronic book while driving is not a reasonable application of that apparatus. The Hartman reference adds nothing to overcome this basic deficiency of

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Harada.

As best understood, the Examiner is arguing that a correlation exists between LCD-based displays and mounting into vehicles so that, if one reference uses an LCD-based display in a vehicle, then it is obvious that any LCD-based display would be similarly mounted in a vehicle. Applicants respectfully maintain that no such correlation exists.

Applicants additionally respectfully assert that the Examiner's reliance upon a similarity that would be shared if two references were to be combined as being logic that is backwards from that required for an analysis under 35 USC §103(a).

That is, as best understood, the Examiner considers as a proper motivation to mount the Harada apparatus into a vehicle, even though Harada itself explicitly requires that the apparatus be portable (i.e., inherently meaning that it is unattached to any surface), as being that the combination would thereby result in having an LCD display device being mounted into a vehicle, which condition would thereby be similar to the condition in Hartman in which an LCD display device is mounted in a vehicle.

The simple fact that Hartman teaches an LCD apparatus that is mounted in a vehicle does not at all imply that every LCD device is, therefore, obviously intended to be mounted in vehicle. That is, there is no reasonable logical connection whatsoever in saying that, because the Hartman device has an LCD-based display and is mounted in a vehicle, then, based on that combination of traits in Hartman, every device having LCD-based displays are, therefore, rendered as obvious to be mounted in a vehicle. There is no suggestion in Hartman to modify the LCD apparatus to conform with that of Harada. Nor is there any suggestion in Harada to mount the electronic book into a vehicle. And, indeed, Harada requires that the device described therein be completely portable.

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Fourth, as previously stated in the Amendment Under 37 CFR 1.111 filed on September 3, 2002, Applicants again directs the Examiner's attention to MPEP §2143.01, which clearly states: "If proposed modification would render the prior art invention being modified unsatisfactorily for its intended purpose, then there is no suggestion or motivation to make the proposed modification" (emphasis by Applicants).

The intended purpose for the apparatus described in Harada is repeatedly described, perhaps best in the very first paragraph beginning at line 1 of column 1: "The present invention relates to a portable image display device for printed materials such as books, and more particularly to image display device and method having an open display function like a book as well as portability and suitable for displaying electronic sheet information".

Indeed, the entire purpose for the hinged structure for the Harada apparatus directly relates to its intended portability, as clearly stated at lines 25-27 of column 2: "... said book type main body is folded to fold the display screens over each other to facilitate the carrying."

These two themes of intended use of the apparatus for reading material and for portability are repeated throughout the entire disclosure of Harada. For example, at lines 20-50 of column 5, it is explained that the device is intended to take the place of newspapers, books, magazines, etc., by serving as the display device for "electronic media". Harada intends that automatic vending machines at shops at (commuters') stations or on the streets would sell the diskettes permitting commuters to purchase the latest "electronic column information" to view while commuting.

Indeed, the portability is critical for the purpose of the Harada apparatus, as very specifically described exemplarily at lines 40-48 of column 7:

"As the next requirement, it is necessary to provide the portability and easiness of the

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newspaper and magazine to the display device. In general, in the books, the "easiness to read anywhere" is a natural requirement and it is necessary to solve the natural property by reducing the size and weight of the display device. It is necessary for the replacement of the book to meet that it can be always carried anywhere, may be used even in a narrow space and the user does not feel the weight during use." (Emphasis by Applicants)

In complete contrast to being portable and used to display reading material, the present invention is intended to be mounted on a surface and is intended to be used to provide a user interface (display and control) with one or more systems in a vehicle.

Therefore, Applicants again point out to the Examiner that the Harada reference, based on the above-cited instruction from MPEP §2143.01, cannot be combined with a reference suggesting use in a vehicle when Harada itself so strongly states its intended purpose as being for reading material and states that its purpose requires portability.

Accordingly, since the entire rejection on record depends upon a primary reference with such stringent requirement for portability, the entire present invention described by claims 1-30 is completely patentable over the Harada-based rejection.

A similar argument applies for each of the other secondary references that the Examiner relies upon, as follows.

Jin cannot be combined with Harada, since the resultant combination would render the Harada apparatus useless as a display for reading an electronic book (one half of the page to be read would be taken out-of-view of the reader).

Pabon cannot be combined with Harada, since Harada has no second function: its sole purpose is that of providing a display for an electronic book.

Nakadozono cannot be combined with Harada, since the simple hinge of Harada requires no sensor and none is suggested in Harada. Additionally, Applicants assert that the

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sensors taught in Nakadozono have no relation whatsoever to the technique of the present invention in which the orientation of the display device itself is being sensed. The sensors described in this reference are all sensing conditions external to the apparatus.

Neither Ishii nor Kamamoto can be combined with Harada since the sole purpose of Harada is that of providing a reading display. There is no suggestion to add audio. The Examiner is not authorized to re-define the primary reference Harada for the convenience of combining with a secondary reference.

B. Criticality of "first panel mounted onto a surface in the vehicle"

As best understood, the Examiner raises a first issue that Applicants have failed to show "... in drawings or claims any details of mounting to any surface including the surfaces in vehicle's (sic)". The Examiner is understood as raising a second issue that Applicants fail to demonstrate "... the criticality of "first panel mounted onto a surface in the vehicle." "

In response, relative to the first issue, Applicants respectfully maintain that the purpose of a patent disclosure, i.e., that of teaching the present invention to one of ordinary skill in the art, would not at all require, in the case of the present invention, that a figure specifically show a detail mounting technique to a vehicle surface. Since there would be no novelty in the specific details of mounting the present device to a surface in a vehicle, Applicants believe that a person of ordinary skill in the art of vehicle display devices would have no problem whatsoever in mounting the device described by the present invention, using any of a number of well known and conventional mounting techniques. As stated in MPEP 608.02, a drawing is required only if such figure is "necessary for the understanding of the invention".

In response to the second issue concerning whether or not Applicants have articulate a

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"criticality" of using the present invention in a vehicle, Applicants respectfully maintain that the "criticality" has been articulated beginning at sentence 1 of page 1 of the instant disclosure. The explicit reference that the present invention concerns mounting within a vehicle continues uninterrupted throughout the entire disclosure, including the very final sentence of the disclosure, wherein it is stated that the "... vehicle-mounted apparatus can be used more conveniently". Applicants do not believe that a person of ordinary skill in the art, who has read the disclosure of the instant Application, could reasonably consider that it fails to address a vehicle-mounted display apparatus.

The present invention provides a solution to several problems that particularly plague displays for vehicles. For example, in direct contrast to the problem described in lines 33-52 of column 1 of Harada in which an LCD display must be enlarged for a display intended for reading newspapers, etc., in order to allow the required resolution, a display for a vehicle requires that size be reduced (see page 1 at line 25 of instant specification).

A second very important problem addressed by the present invention, as described beginning at line 13 of page 2 and continuing through line 15 of page 4 is that conventional vehicle displays have complicated switching and display protocols. The present invention provides eloquent solutions to these problems.

That is, for example, the present can serve as an audio control panel when in the closed position, including providing a display function for the audio system in the portion of the first display that is exposed when the second panel is in the closed position. When the second panel is opened, the two displays automatically provide the appropriate displays for a second system, such as a navigator display or a television screen, in addition to any displays required by the original audio system.

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The present invention can also automatically adapt the control switch functions and displays based upon whether the second panel is open and whether the second panel has been rotated upside down. This aspect of the present invention reduces the complication and confusion of the switching and display choices of conventional in-vehicle display panels, thereby providing an in-vehicle display apparatus that is much more easily operated by the operator of the vehicle who is easily distracted by having to figure out how to switch displays, which switches control functions in various systems controlled by the display panel, and how functions on multiple systems are controlled by which switches when systems are switched on and off.

Accordingly, Applicants respectfully submit that the discussion on pages 1 through 4 of the instant disclosure do indeed provide a very articulate presentation of the criticality of the present invention for the specific environment of being mounted in a vehicle.

C. The Rejection for the New Claims 23-30

It is noted that the Examiner fails to properly address claims 23-30 added by the last Amendment. As best understood, the Examiner takes official notice for all these new claims. In response, Applicants respectfully request that the Examiner provide a reasonable citation addressing these claims.

More specifically, the rejection on record fails to provide any dual-panel LCD apparatus mounted on any surface, let alone an apparatus having switches on the back side of the second panel or an apparatus having a portion of the first display visible when the panels are in the closed position.

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D. The Examiner's Response to Applicants' Arguments

The Examiner responds that the combination of the secondary references with the primary reference Harada is justified for two reasons.

First, the Examiner asserts, relative to the rejection for claims 2-3, 6, 8, 9, 11, and 15-18, that "it is not necessary that the references actually suggest, expressly or in so many words, the changes or improvements that applicant has made. The test for combining references is what the references as a whole would suggested (sic) to one (sic) ordinary skill in the art. In re Sheckler, 168 USPQ 716 (CCPA 1971); In re McLughlin (sic) 170 USPQ 209 (CCPA 1971); In re Young 159 USPQ 725 (CCPA 1968)."

Applicants respectfully submit that the above sentence, similar to others in the MPEP, when taken out of context of the very specific facts of the case, is not authorization for Examiners to ignore well-established doctrine.

A first basic flaw in applying this statement to the facts of the instant Application is that these cases did not involve a primary reference that expressly teach against the urged combination. That is, this statement is not intended to authorize an Examiner to totally ignore and to totally defeat the intended purpose of the primary reference by making a combination. As previously pointed out in the previous Amendment, MPEP 2143.01 very clearly state: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination". In choosing to rely on these two sentences, the Examiner attempts to circumvent this very basic doctrine.

A second basic flaw to the Examiner's invocation of the above statement is that the Examiner seems to fail to understand the phrase "as a whole". The significance is described in MPEP 2141.02: "In determining the difference between the prior art and the claims, the question under 35 USC 103 is not whether the differences themselves would have been

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obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 283 USPQ 698 (Fed. Cir. 1983)" (emphasis in MPEP).

The following explanation of the significance of "as a whole", as contained in the final paragraph of MPEP 2141.02, is particularly relevant to the rejection on record: "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" (emphasis in MPEP). Applicants contend that the Examiner has failed to even acknowledge that the primary reference Harada very clearly teaches against the mounting of its LCD apparatus on any surface.

Accordingly, Applicants respectfully maintain that the statements relied upon by the Examiner are irrelevant to the present rejection in that the facts of these cases do not cover the situation of the instant rejection in which the primary reference itself precludes the urged combination.

Second, the Examiner asserts, relative to the rejection for claims 7, 10 and 19-22, that:

"... the test for obviousness is not whether the features may be bodily incorporated into the other to produce the claimed subject matter but simply what the references make obvious to the one ordinary skill (sic) in the art. In re Richman 165 USPQ 509, (CCPA 1970); In re Bozek, 163 USPQ 545, (CCPA 1969); In re Beckum, 169 USPQ 47 (CCPA 1971); In re Sneed 710 F 2d 1544, 218 USPQ 385."

In response to the above statement, Applicants respectfully point out that it fails to dispute the Applicants' argument of the previous Amendment. In that Amendment, Applicants pointed out that the switch in the Kamamoto reference fails to switch between sources. The Examiner's reliance upon the above statement is very puzzling. As best understood, the Examiner considers that a proper evaluation under 35 USC §103(a) requires only that elements missing in the primary reference be located somewhere in the prior art.

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That is, from the Examiner's position, as best understood from the record, an LCD view finder on a video camera that is mounted on a rotary switch somehow renders obvious the use of a rotary-switched LCD panel in all applications.

The basic flaw with the Examiner's position and the invocation of the above sentence is that an invention may very well be very well include elements that are well known in the art or may very well be merely a new combination of well known elements. That is, by simply showing that a rotary-switched LCD panel is a known element, the Examiner fails to demonstrate that its use in the claimed combination is, therefore, obvious. This statement is particularly true when the isolated element would add no useful feature into the primary reference, as is certainly true for the Harada apparatus.

For the reasons stated above, the claimed invention is fully patentable over the cited references.

E. The Rejection on Record in Light of *In re SANG-SU LEE*

Before concluding the evaluation so as to proceed with appeal, Applicants urge the Examiner to review the recent Federal Circuit decision *In re Sang-Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). That decision would seem particularly relevant to the current rejection on record, in which conclusory statements are relied upon for the essence of the rejection and the explicit contrary teachings in the primary reference Harada are totally ignored in the evaluation. Indeed, the Lee decision even refers to the *In re Bozek* case cited by the Examiner in the Final Office Action of the instant Application.

In summary of *In re Sang-Su Lee*, the invention in that case was directed toward a method of automatically displaying functions of a video display device. These automatic

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displays demonstrate how to select and adjust functions, thereby facilitating a response by a user. The examiner rejected the claims as being obvious over two references, US Patent 4,626,892 to Nortrup and the operations handbook for a video game Thunderchopper.

The Nortrup reference describes a television set having a menu display by which the user can adjust various picture and audio functions but does not include a demonstration of how to adjust the functions. The Thunderchopper handbook describes the Thunderchopper game's video display as having a "demonstration mode" showing how to play the game but makes no mention of the adjustment of picture or audio functions. In the Examiner's Answer for the appeal, the examiner merely stated that both the Nortrop function menu and the Thunderchopper demonstration mode are program features and that the Thunderchopper mode "is user-friendly" and functions as a tutorial, and that it would have been obvious to combine them. On appeal, the Board stated: "The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without specific hint or suggestion in a particular reference."

In vacating and remanding the Board's decision, Judge Newman wrote that "*Bozek* did not hold that common knowledge and common sense are a substitute for evidence, but only that they may be applied to analysis of the evidence. *Bozek* did not hold that objective analysis, proper authority, and reasoned findings can be omitted from Board decisions. Nor does *Bozek*, after thirty-two years of isolation, outweigh the dozens of rulings of the Federal Circuit and the Court of Customs and Patent Appeals that determination of patentability must be based on evidence.... The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies."

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Applicants respectfully submit that the motivations to combine references contained in the present rejection are, at best, merely conclusory statements devoid of any reasonable objective motivation to combine references, as required by the recent *In re Lee* decision. That is, without first acknowledging, taking into account, and dispensing with the explicit contrary teaching in the primary reference Harada, any motivation to combine Harada with a secondary reference can only be considered only inherently conclusory.

III. FORMAL MATTERS AND CONCLUSION

Further, the Examiner is again requested to acknowledge the receipt of the priority document filed January 4, 2001, with the Application.

In view of the foregoing, Applicant submits that claims 1-30, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

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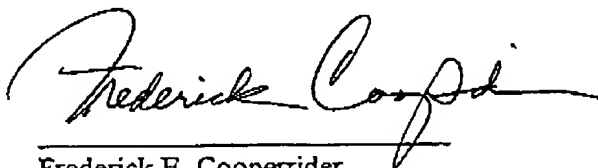
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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date:

12/20/02

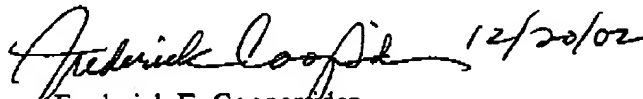


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CERTIFICATION OF TRANSMISSION

I certify that I transmitted via facsimile to (703) 872-9315 this Amendment Under 37 CFR §1.116 to Examiner L. Shapiro on December 20, 2002.



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

The claims have been amended, as follows:

1. (Amended) A vehicle-mounted apparatus, comprising:
 - a first panel including a first display, said first panel adapted to be mounted onto a surface of [[said] a vehicle]; and
 - a second panel including a second display, wherein said second panel is adapted to be opened and closed with respect to said first display about a side thereof as an axis.
23. (Amended) A display device, comprising:
 - a first panel including a first display, said first panel adapted to be mounted on a surface; and
 - a second panel including a second display, said second panel adapted to be opened and closed with respect to said first [display] panel about an axis located at an edge of said first display.